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Janice A. Kehrli

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EXAMINER

SHERR, CRISTINA O

ART UNIT

PAPER NUMBER

3685

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/008,388	Applicant(s) KEHRLI ET AL.	
	Examiner CRISTINA SHERR	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) 2-6,21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 9-18, 20, and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to Applicant's Amendment filed September 2, 2008. Claims 1-7, 9-18, and 20-23 are currently pending in this case. Claims 1, 9, 20, and 23 are currently amended. Claims 8, 19, 24, and 25 were previously canceled. Claims 2, 3, 4, 5, 6, 21, and 22 were withdrawn pursuant to an earlier Requirement for Election/Restriction. Accordingly, claims 1, 7, 9-18, 20, and 23 are currently under examination.

Response to Arguments

2. Applicant's arguments, filed September 2, 2008, with respect to the section 112 have been fully considered in light of the current amended version of the claims and are persuasive. The section 112 rejection of claims 9-11 has been withdrawn.

3. Applicant's arguments regarding the section 103 rejections filed September 2, 2008 have been fully considered but they are not persuasive.

4. Applicant argues, regarding claims 1, 20 and 23, that nothing in the cited reference teaches, discloses or suggests "calculating a combined profitability of the portfolio and the additional mortgage loan", but that the reference rather calculates future profitability based on both the mortgage loan and "other obligations".

5. Examiner respectfully disagrees and directs attention to Freeman, at, e.g., col 15 ln 65 – col 16 ln 14, where different types of loans are described as being separately graphed. In other words, each loan has its bar and the height of different bars on the graph is attributed to the difference in the type of loan. Because Freeman is looking at or considering different types of loans or obligations separately, and thus giving them

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different weights, it would be obvious that one variation of this would be to give mortgage loans all the "weight" and no weight at all to other loans in predicting future profitability.

Remarks

6. With respect to the current amendments to the claims, we note that a wherein clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim. (*Texas Instruments Inc. v. International Trade Commission*, 26, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001).

7. With respect to claim 20, we note that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). In this case, we find that that the apparatus of claim 20 is comprised of a processor and storage device. The various determinations and calculations performed refer to what the apparatus rather than what it is, and thus would not serve to distinguish the claim from the prior art.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 7, 9-18, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al (US 6,249,775).

10. Regarding claim 1 –

11. Freeman discloses a method to facilitate analysis of a commercial mortgage backed security portfolio (e.g. col 1 ln 5-10), comprising:

determining base information associated with a commercial mortgage backed security portfolio associated with a plurality of mortgage loans; (e.g. col 3 ln 10-21)

determining information associated with an additional mortgage loan to be added to the portfolio in accordance with a contribution of the additional mortgage loan to the portfolio, including at least one desired profitability value for the additional mortgage loan; (e.g. col 15 ln 35-43)

12. calculating the loan spread associated with the additional mortgage loan in accordance with a contribution of the additional mortgage loan to the portfolio; (e.g. col 12, ln 32-45; note also that, as above, Freeman, at, e.g., col 15 ln 65 – col 16 ln 14, discloses where different types of loans are described as being separately graphed. In other words, each loan has its bar and the height of different bars on the graph is attributed to the difference in the type of loan. Because Freeman is looking at or considering different types of loans or obligations separately, and thus giving them different weights, it would be obvious that one variation of this would be to give mortgage loans all the "weight" and no weight at all to other loans in predicting future profitability)

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calculating a combined profitability of the portfolio and the additional mortgage loan based on combined category sizes for the plurality of mortgage loans and the additional mortgage loan (e.g. col 13 ln 50-65, col 14 ln 15-25).

13. Freeman does not disclose transmitting the above information to a user terminal via network. However, official notice is taken that such transmission is old and well known since the Internet and other such networks have come into widespread use.

14. Regarding claim 7 –

15. Freeman discloses calculating the loan spread associated with the additional mortgage loan in accordance with a contribution of the additional mortgage loan to the portfolio. (e.g. col 12 ln 59- col 13 ln 4).

16. Regarding claim 9 –

17. Freeman discloses wherein the determination of category sizes for the additional mortgage loan is based on at least one of: a property type, a risk value, debt service coverage ratio information, and loan to value information. (e.g. col 13 ln 11-25).

18. Regarding claim 10

19. Freeman discloses adding the category size for the additional mortgage loan to the current category size to determine a combined category size for each credit rating category. (e.g. col 13 ln 60-65)

20. Regarding claim 11 –

21. Freeman discloses determining an original profitability of the portfolio; calculating a combined profitability of the portfolio and the additional mortgage loan based on the combined category sizes; and subtracting the original profitability from the combined

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profitability to determine a profitability of the additional mortgage loan. (e.g. col 13 ln 60-67).

22. Regarding claim 12 –

23. Freeman discloses wherein calculation of the loan spread is an iterative process. (e.g. col 16 ln 36-45).

24. Regarding claim 13 –

25. Freeman discloses wherein the iterative process includes: determining a trial loan spread for the additional mortgage loan; computing a resulting profitability based on the trial spread; and adjusting the trial loan spread, wherein said computing and adjusting are repeated until the resulting profitability is within a predetermined range of the desired profitability. (e.g. col 13 ln 49=59, col 12 ln 59- col 13 ln 4).

26. Regarding claim 14 –

27. Freeman discloses wherein said adjusting is based on duration of the additional mortgage loan. (e.g. col 4 ln 61 – col 5 ln 5).

28. Regarding claim 15 –

29. Freeman discloses wherein said adjusting comprises: determining an original duration of the portfolio; calculating a combined duration of the portfolio and the additional mortgage loan; and subtracting the original duration from the combined duration to determine the duration of the additional mortgage loan. (e.g. col 4 ln 61 – col 5 ln 5).

30. Regarding claim 16 –

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31. Freeman discloses wherein the method is performed for a plurality of desired profitability values to determine a plurality of loan spread values. (e.g. col 15 ln 20-30).

32. Regarding claim 17 –

33. Freeman discloses wherein said calculating is performed via a substantially real-time pricing application. (fig. 5).

34. Regarding claim 18 –

35. Freeman discloses wherein said calculating is further performed utilizing a function library adapted to generate loan and/or commercial mortgage backed securities cash flows. (e.g. col 16 ln 55-65).

36. Regarding claims 20 and 23 –

37. Claims 20 and 23 are rejected under the same criteria as above.

38. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

39. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

40. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

42. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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43. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRISTINA OWEN SHERR
Examiner
Art Unit 3685

Cristina Owen Sherr, AU 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685

<div>Application Number</div> <div></div>	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/008,388	KEHRLI ET AL.	
	Examiner	Art Unit	
	CRISTINA SHERR	3685	